



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,843	08/02/2001	Yoshihiko Obata	1506-1010	5667

21171 7590 12/01/2006

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

VAN BRAMER, JOHN W

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/919,843	Applicant(s) OBATA, YOSHIHIKO	
	Examiner John Van Bramer	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed September 5, 2006 cancelled claims 9-12. Claims 1, 7, and 8 were amended and no new claims were added. Therefore, the currently pending claims are Claims 1 – 8.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Amended claims 1, 7 and 8 introduce the phrase “an amount of an incentive to be distributed to the participants”. The term “incentive” is not found in the specification and it is unclear as to whether this is a second reward that is given to all participants or whether the term “incentive” is analogous to the total return value that is to be distributed to only those participants that selected adopted options and thus earned points. The examiner has interpreted the term incentive to be analogous to the total return value that is to be distributed and the term “the participants” to mean those participants that earn points by selecting adopted options. The examiner suggests correcting these terms in order use language,

which is consistent with the rest of the claims and the specification. Additionally, the proper antecedent basis should be used regarding the "participants".

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3-4 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bahar et al. (U.S. Patent Number: 6,694,355) in view of Walker et al. (U.S. Patent Number: 6,616,458) further in view of Crane (Burton Crane "The Sophisticated Investor", 1964. Crane (page 230, lines 3-14)

Claims 1 and 4: Behar discloses a profit sharing method used for designing a product having a plurality of elements modifiable to adapt to fashion trends, the method being executed by a server computer and comprising:

- a. Providing participants with a questionnaire including a plurality of questions, each question concerning an element of the product, asking each participant

to select one option from a plurality of options for the element of the product in each question. (Col 5, lines 36 – 56, and Fig. 3) (A questionnaire is not limited to text based representation. The outline Fig. 3, 302 shown a number of sections from which a user decides the type of part to use in each section. Therefore, each section represents a multiple-choice question. Since each section has multiple possible parts that can be selected, these parts represent possible answers to each multiple-choice question. Hence, Behar is providing participants with a questionnaire, with a plurality of questions and each question has a multiplicity of answers.)

- b. Retrieving answers to the questionnaire including pieces of answer information each specifying the one option for each question selected by a participant from the plurality of options corresponding to the element in each question. (Col 6, lines 12 – 41)
- c. Specifying one adopted option from the plurality of options of each question of the questionnaire corresponding to the element, based on the retrieved pieces of answer information (Col 6, lines 29 – 41).
- d. Determining a final design of the product in which each element is as specified in the corresponding one adopted option. (Col 6, lines 29 – 41)
- e. Assigning predetermined points to each participant for each question if the participant selected the corresponding one adopted option from the plurality of options of the question (The measure of each degree of variance between the final design and the pre-determined design scheme) wherein for each

Art Unit: 3622

respective element, all of the participants who have selected the adopted option on the questionnaire are specified and respectively given points corresponding to a weighed value which is predetermined for the element (Col 6, lines 29 – 41) (The award incentive)

- f. Determining an individual return value, which should be given to the participant in accordance with the predetermined points, assigned to the participant. (The award incentive) (Col 6, lines 29 – 41)

While Behar does not explicitly state that the one adopted option is specified independently of a result of a specification of any other element, the analogous art of Walker discloses selecting adopted options that are independent of other elements within a survey (Col 13, lines 54-63). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select the option presented by each individual question, which generates the most favorable response as the adopted option. One would have been motivated to do this in order to develop a product that has the broadest appeal, corresponds to the trends and styles of the time, and therefore maximized potential sales (Col 6, lines 59-64)

While Behar does not explicitly state the mechanism used to identify where the funds for the incentive are obtained, It is old and well known in the market research art that when clients request a survey to be conducted that they will pay a set fee to the market research firm for conducting the survey. It is also well known in the market research art that survey participation increases when a

reward is provided to the participant. The total amount of rewards provided must be less than the fee received in order to maintain profitability. The teachings of Crane, disclose a method for distributing rewards (dividends) to participants (share holders) that involves determining "a unit return value" and multiplying the unit return value by the number of participant points (shares owned). Using the Crane payment distribution methodology in the invention of Bahar would have been obvious to one of ordinary skill in the art at the time of the application. One would have been motivated to do this in order to provide a reward to a participant that is commensurate with the amount input they provided. This would provide an enticement for continued participation and provide participants with a sense of accomplishment.

Additionally, the Applicant's specification provides no positive motivation regarding the use of the disclosed payment methodology over other well-known methods for reimbursing participants in a survey. It appears to be an arbitrary design consideration, which fails to patentably distinguish over Bahar et al..

Therefore, it would have been an obvious matter of design choice to modify Bahar et al. to obtain the invention as specified in the claim(s).

Finally, while the examiner has addressed each limitation as currently claimed, the inclusion of wherein clauses in the claim are given little or no patentable weight because they indicate possible result or outcomes and are not directly recited as steps within the scope of the claim itself. The examiner suggests rewriting the "wherein" clauses to recite positive steps towards achieving an

outcome. For example, the phrase "wherein the incentive to be distributed to" is forward looking and no distribution is occurring. Instead the step should be directed toward the active step of "distributing".

Claim 3: Bahar, Walker and Crane disclose a method according to claim 1, wherein each piece of answer information specifies, as to a plurality of elements, options which characterize the product, respectively. (Col 5, lines 36 – 56, and Fig. 3)

Claim 6: Bahar, Walker and Crane disclose a method according to claim 1, further comprising a step of creating image data of the product characterized by at least one adopted option (Col 6, lines 49-51).

Claim 7: Bahar discloses a profit sharing method executed by a client computer connectable to a server computer, the method comprising:

- a. Receiving a questionnaire including a plurality of questions, each question being directed to an element characterizing a commercial article. (Col 5, lines 36 – 56, and Fig. 3)
- b. Obtaining pieces of answer information each specifying at least one option selected by a participant from options corresponding to each question (Col 6, lines 12 – 17)

- c. Sending the obtained pieces of answer information to the server computer to determine said server computer to execute (Col 6, lines 13-16).
- d. Specifying one adopted option corresponding to the element, based on the pieces of answer information received from the client computer and determining a final design of the commercial article according to the one adopted option for each of the plurality of questions of the questionnaire. (Col. 6, lines 29-41) wherein the one adopted option is specified independently of a result of a specification to any other element.
- e. Assigning predetermined points to a participant who selected said one adopted option as the at least one option. (The measure of each degree of variance between the final design and the pre-determined design scheme) (Col. 6, lines 29-41) wherein for each respective element all of the participants who have selected the adopted option are specified and respectively given points corresponding to a weight value which is predetermined for the element. (Col 6, lines 29 – 41) (The award incentive)
- f. Determining individual return values that should be respectively given to participants in accordance with the predetermined points assigned to the participants. (Col 6, lines 29-41)

While Behar does not explicitly state that the one adopted option is specified independently of a result of a specification of any other element, the analogous art of Walker discloses selecting adopted options that are independent of other elements within a survey (Col 13, lines 54-63). Therefore, it would have been

Art Unit: 3622

obvious to one of ordinary skill in the art at the time the invention was made to select the option presented by each individual question, which generates the most favorable response as the adopted option. One would have been motivated to do this in order to develop a product that has the broadest appeal, corresponds to the trends and styles of the time, and therefore maximized potential sales (Col 6, lines 59-64)

While Behar does not explicitly state the mechanism used to identify where the funds for the incentive are obtained, It is old and well known in the market research art that when clients request a survey to be conducted that they will pay a set fee to the market research firm for conducting the survey. It is also well known in the market research art that survey participation increases when a reward is provided to the participant. The total amount of rewards provided must be less than the fee received in order to maintain profitability. The teachings of Crane, disclose a method for distributing rewards (dividends) to participants (share holders) that involves determining "a unit return value" and multiplying the unit return value by the number of participant points (shares owned). Using the Crane payment distribution methodology in the invention of Bahar would have been obvious to one of ordinary skill in the art at the time of the application. One would have been motivated to do this in order to provide a reward to a participant that is commensurate with the amount input they provided. This would provide an enticement for continued participation and provide participants with a sense of accomplishment.

Additionally, the Applicant's specification provides no positive motivation regarding the use of the disclosed payment methodology over other well-known methods for reimbursing participants in a survey. It appears to be an arbitrary design consideration, which fails to patentably distinguish over Bahar et al..

Therefore, it would have been an obvious matter of design choice to modify Bahar et al. to obtain the invention as specified in the claim(s).

Finally, while the examiner has addressed each limitation as currently claimed, the inclusion of wherein clauses in the claim are given little or no patentable weight because they indicate possible result or outcomes and are not directly recited as steps within the scope of the claim itself. The examiner suggests rewriting the "wherein" clauses to recite positive steps towards achieving an outcome. For example the phrase "wherein the incentive to be distributed to" is forward looking and no distribution is occurring. Instead the step should be directed toward the active step of "distributing".

Claim 8: Bahar discloses a computer readable medium containing a profit sharing program comprising:

- a. A module making a server computer to issue a questionnaire including a plurality of questions, each question being directed to an element characterizing a commercial article, and having a plurality of options as possible answers to the question. (Col 5, lines 36 – 56, and Fig. 3)

- b. A module making the server computer to acquire pieces of answer information, each piece of information specifying at least an option selected for a question by a participant. (Col 6, lines 29-32 and lines 13-16).
- c. A module making the server computer to select for each question one option corresponding to the element, based on the acquired pieces of answer information and the determine a final design of the commercial article according to the adopted option for each element. (Col 6, lines 29-36)
- d. A module making the server computer to assign for each question predetermined points to a participant who selected the adopted option. (The measure of each degree of variance between the final design and the pre-determined design scheme) (Col. 6, lines 32-35) wherein for each respective element, all of the participants who have selected the adopted option on the questionnaire are specified and respectively given points corresponding to a weight value which is predetermined for the element. (Col 6, lines 29 – 41) (The award incentive)
- e. A module making the server computer to determine individual return values that should be respectively given to participants in accordance with the predetermined points assigned to the participants. (Col 6, lines 29-33)

While Behar does not explicitly state that the one adopted option is specified independently of a result of a specification of any other element, the analogous art of Walker discloses selecting adopted options that are independent of other elements within a survey (Col 13, lines 54-63). Therefore, it would have been

obvious to one of ordinary skill in the art at the time the invention was made to select the option presented by each individual question, which generates the most favorable response as the adopted option. One would have been motivated to do this in order to develop a product that has the broadest appeal, corresponds to the trends and styles of the time, and therefore maximized potential sales (Col 6, lines 59-64)

While Behar does not explicitly state the mechanism used to identify where the funds for the incentive are obtained, It is old and well known in the market research art that when clients request a survey to be conducted that they will pay a set fee to the market research firm for conducting the survey. It is also well known in the market research art that survey participation increases when a reward is provided to the participant. The total amount of rewards provided must be less than the fee received in order to maintain profitability. The teachings of Crane, disclose a method for distributing rewards (dividends) to participants (share holders) that involves determining "a unit return value" and multiplying the unit return value by the number of participant points (shares owned). Using the Crane payment distribution methodology in the invention of Bahar would have been obvious to one of ordinary skill in the art at the time of the application. One would have been motivated to do this in order to provide a reward to a participant that is commensurate with the amount input they provided. This would provide an enticement for continued participation and provide participants with a sense of accomplishment.

Art Unit: 3622

Additionally, the Applicant's specification provides no positive motivation regarding the use of the disclosed payment methodology over other well-known methods for reimbursing participants in a survey. It appears to be an arbitrary design consideration, which fails to patentably distinguish over Bahar et al. Therefore, it would have been an obvious matter of design choice to modify Bahar et al. to obtain the invention as specified in the claim(s).

Finally, while the examiner has addressed each limitation as currently claimed, the inclusion of wherein clauses in the claim are given little or no patentable weight because they indicate possible result or outcomes and are not directly recited as steps within the scope of the claim itself. The examiner suggests rewriting the "wherein" clauses to recite positive steps towards achieving an outcome. For example the phrase "wherein the incentive to be distributed to" is forward looking and no distribution is occurring. Instead the step should be directed toward the active step of "distributing".

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bahar et al. (U.S. Patent Number: 6,694,355) in view of Murphy (MM, MM ... BLUE! PUBLIC OBVIOUSLY WAS READY FOR A CHANGE IN M&M COLORS: [CITY Edition] Marli Murphy KANSAS CITY STAR. Dayton Daily News. Dayton Ohio: Aut 19, 1995. pg. 3.C).

Art Unit: 3622

Claim 2: Bahar, Walker and Crane disclose the method according to claim 1, but is silent with regard to the specific method in which the adopted option is elected.

However, the analogous teachings of Murphy disclose a manufactured commercial article in which participants determined the design of a product enhancement based upon the option selected by most participants. Therefore, choosing the adopted option as the one identified as most desirable from participants would have been obvious to one of ordinary skill in the art at the time of the application. One would have been motivated to do this in order to allow the manufacture to design a product that will maximize potential sales based upon identified user trends. In fact, Bahar mentions (Col 6, lines 59-63) that such identification would benefit the manufacturer.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bahar et al. (U.S. Patent Number: 6,694,355) in view of West et al. (U.S. Patent Number: 6,175,833).

Claim 5: Bahar, Walker and Crane disclose a method according to claim 1, but is silent regarding transmitting the final results of the questionnaire to the participant. However, the analogous teachings of West disclose providing participants in a survey with the results of the survey (Col 9 lines 37-43). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate sending participant in the questionnaire of Bahar the final results of the survey. One would have been motivated to do this in order to allow participants to see how their

Art Unit: 3622

opinions have affected the final design of the product and to encourage them to continue to participate in the future.

Response to Arguments

9. Applicant's arguments filed September 5, 2006 have been considered but are moot in view of the new ground(s) of rejection necessitated by amendments to the claims.

Conclusion

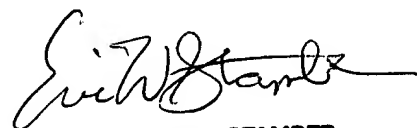
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


jvb



ERIC W. STAMBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600